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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/032,577      | 01/02/2002  | Aurelio Molari       | Q67903              | 5846             |

7590 08/24/2004

SUGHRUE MION, PLLC  
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Washington, DC 20037-3213

EXAMINER

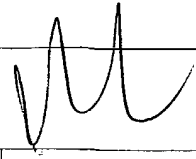
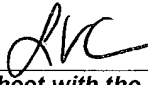
CIRIC, LJILJANA V

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| ART UNIT | PAPER NUMBER |
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3753

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |  |  |
|------------------------------|--|--|
| <b>Office Action Summary</b> | Application No.<br>10/032,577  | Applicant(s)<br>MOLARI ET AL.  |
|                              | Examiner<br>Ljiljana (Lil) V. Ciric  | Art Unit<br>3753   |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004 and 10 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. This Office action is in response to the amendments and arguments filed on March 10, 2004 and on June 2, 2004.
2. Only new claims 11 and 12 remain in the application.

### *Response to Arguments*

3. Applicant's arguments filed on March 10, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the Zechin reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "and [sic] engine and gear box combination in the *engine* compartment") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the examiner hereby wishes to reiterate that the claims in a pending application should be given their *broadest* reasonable interpretation. See *In re Pearson*, 181 USPQ 641 (CCPA 1974). Applicant's arguments, on the other hand, rely on an inappropriately narrow interpretation of the claims in the instant pending application. For example, Zechin most certainly does show an engine and gear box combination 42 and also most certainly shows the manifold or duct 20 as extending laterally or to a side (albeit an upper side) of the engine above the gearbox. Finally, applicant's argues that the hot water core 56 of Zechin cannot be considered an engine cooling radiator "by any stretch of the imagination" and that Zechin "provides the engine cooling radiator in front of the engine and the fan which is mounted on the front of the engine"; however, no element corresponding to such an engine cooling radiator *disposed in the front of* the engine and the fan is provided by the applicant and no such

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element is identified by the reference. On the contrary, the hot water core 56 is disclosed as being heated by hot water from the engine, thus cooling the engine and radiating the heat to ambient via the core 56—i.e., an engine cooling radiator. See column 3, lines 39-51.

Applicant is also respectfully reminded that claims directed to apparatus *must* be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Also, “[A]pparatus claims cover what a device *is*, not what a device *does*. (Emphasis in original). *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

#### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the gear box mounted in the front compartment and the manifold extending above the gear box as now recited in claim 11 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any

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required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

5. Receipt and entry of the amended abstract filed on June 3, 2004 is hereby acknowledged.

***Claim Objections***

6. Claim 11 is objected to because of the following informalities: "a" should be inserted immediately preceding "gear box" [claim 11, line 2]. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, there is no antecedent basis for the limitations "the bonnet" and "the engine compartment" as recited in lines 6 and 7 of the claim. If "the engine compartment" is intended to refer to "the front compartment", recommend replacing the former with the latter. Also, a bonnet should be separately and positively recited prior to the recitation of "the bonnet" in line 6.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by *Zechin*.

*Zechin* discloses a motor vehicle 10 comprising a passenger compartment 16 with an engine or front compartment 14 arranged in front thereof, an engine 42 and a corresponding gearbox mounted in the

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front compartment 14; a heat exchanger unit or heater enclosure 30 comprising an engine cooling radiator 56 [see column 3, lines 39-51] arranged behind the engine 42 and in front of the passenger compartment 16 as shown in Figure 1, for example; a manifold or duct 20 extending to an upper side (i.e., laterally) of the engine 42 above the gear box for conveying a flow of air; the manifold or duct 20 having an inlet 22 arranged in a front portion of the front compartment 14 and an outlet arranged in a rear portion of the front compartment 14 adjacent the heat exchanger unit 30.

The reference thus reads on the claim.

*Allowable Subject Matter*

11. Claim 12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure..

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925.

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While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (703) 308-1272.

The NEW central official fax phone number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

August 21, 2004

  
LJILJANA V. CIRIC  
PRIMARY EXAMINER  
ART UNIT 3753